

### **REMARKS**

This paper is responsive to the Office Action mailed November 2, 2005 in the above-mentioned application. Claims 43-52, 56 and 75 have been amended. Claims 59-74 have been canceled without prejudice or disclaimer. Claims 79-83 have been added. No new matter has been added.

#### **Rejections Under 35 U.S.C. § 102**

Claims 43-50, 56-60, 64-72 and 75-78 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Smith et al. (U.S. Patent No. 6,253,210). Notably, claims 59-60 and 64-72 have been canceled without prejudice or disclaimer.

Smith discloses a system and method for producing composite data in which a user collects "subject data" (e.g., an image) and then requests "co-registered data" (e.g., text and/or images) associated with the subject data from a server. The server retrieves pre-stored co-registered data and creates a mapping relationship between the subject data and pre-stored co-registered data to enable the co-registered data to be presented in composite with the subject data. Images from the co-registered data are deformed (for example, changed in size or orientation) in order to enable a comparison between the subject data and the co-registered images. The composite data including both the subject data and the co-registered data is then provided to the user for viewing via a browser.

In contrast to the present invention recited in amended independent claims 43, 47, 56 and 75, the Smith patent does not teach or suggest a system and method in which a new image is received and compared with stored images in order to determine what text should be associated with the new image. In Smith, a pre-defined set of co-registered data is provided for each new image or "subject data" collected by the user. There is no comparison of the subject data with stored images and no use of the results of this comparison to ascertain what text should be associated with the subject data.

In the Office Action, the Examiner suggests that the function of correlating the subject data and the co-registered data as described in column 4, lines 44-48, of the Smith patent corresponds to the comparison of the new image with the stored images in the present invention.

However, the correlating described in Smith is not a comparison of images, but rather a linking of the images, and therefore different from the comparison performed in the present invention as recited in amended claims 43, 47, 56 and 75 respectively.

The Examiner also suggests that the text selecting step of the present invention is described in column 6, lines 8-14, of the Smith patent. However, this description in the patent describes the selection by the user of one or more types of composite data for viewing once the composite data has been received from the server. The user does not select what text to associate with the subject data, only which of the text already co-registered with the subject data to view. This is distinct from the text selection in the present invention, which is done automatically by the processor in response to the results of the image comparison step. Therefore, amended claims 43, 47, 56 and 75 are believed to be patentable over Smith.

Claims 44-46 depend from amended claim 43 and are believed to be patentable over Smith for at least those reasons set forth above with respect to amended claim 43.

Claims 48-50 depend from amended claim 47 and are believed to be patentable over Smith for at least those reasons set forth above with respect to amended claim 47.

Claims 57-58 depend from amended claim 56 and are believed to be patentable over Smith for at least those reasons set forth above with respect to amended claim 56.

Claims 76-78 depend from amended claim 75 and are believed to be patentable over Smith for at least those reasons set forth above with respect to amended claim 75.

Rejections Under 35 U.S.C. § 103

Claims 55, 61-63 and 73-74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stolfo (U.S. Patent No. 5,668,879) in view of Smith et al. (U.S. Patent No. 6,253,210). Notably, claims 61-63 and 73-74 have been canceled without prejudice or disclaimer.

Stolfo describes a system and method for compressing images to reduce the amount of storage space needed to store images of numerous similar documents such as financial

documents and checks. The system receives a new image, for example, of a check presented to a bank, and compares the image with others stored in the system. If a precise match of the new image is found, the system deletes the new image and stores in its place an identifier to indicate that the image was a precise duplicate of one already stored. If no precise match is found, the system identifies the closest stored match to the new image. The new image is then processed to subtract the stored image from the new image to create a second image representing the difference between the new image and the stored image. Then the new image is deleted and in its place is stored an identifier associated with the stored image along with the second digital image. In this manner, the amount of storage capacity needed to store large quantities of repetitive images is reduced.

In contrast to the present invention as described in claim 55 (depending from amended claim 51), the Stolfo system does not compare a new image with stored images in order to determine what stored text should be associated with the new image. The Stolfo system also deletes images for which a stored match is found to save storage space, in contrast to the present invention in which the new images are stored with the associated text. Therefore, amended claim 55 is believed to be patentable over Stolfo.

New Claims 79-81

New claims 79 –81 recite a method including, *inter alia*, the steps of comparing a new image to stored images to determine whether a predetermined level of similarity exists between the new image and one or more of the stored images, and associating with the new image the stored text associated with the identified stored image when the predetermined level of similarity is identified between the new image and one or more of the stored images. For the reasons discussed above with respect to the Smith and Stolfo references, these new claims are believed to be patentable over the art of record.

The Commissioner is hereby authorized to charge any deficiencies and/or credit any overpayments to Deposit Account No. 01-1420.

This application now stands in allowable form, and reconsideration and allowance are respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP  
Customer Number 25763

Date:

Jan 26, 2006

By:

David E. Bruhn

David E. Bruhn, Reg. No. 36, 762  
Telephone: (612) 340-6317